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09/761,625	01/17/2001	Qi Wang	6956CIP	5289

7590 04/23/2004

Occidental Chemical Corporation
Patent Department
5005 LBJ Freeway
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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 041204

Application Number: 09/761,625
Filing Date: January 17, 2001
Appellant(s): WANG, QI

Richard Fuerle
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/05/2004.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 01/15/2004 has not been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because the invention is not a polymer but a polymer composition comprising a polymer selected from polyvinyl chloride, polycarbonate, polyurethane, polyethylene and polypropylene, the alleged novelty being the presence of about 0.005 to about 10 phr of a stabilizer consistent with at least one of the numerous chemical formulas recited in Claim 25, in the polymer composition.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because 37 CFR § 1.192(c)(7)(1997) provides in pertinent

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part, "[m]erely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." The examiner finds no valid reason why the claims should not be grouped together. Claim 25 is representative of the rejected claims.

(8) *Claims Appealed*

A substantially correct copy of appealed claims, including claims 25-27, 31-34, 36, 38, 39, 42 and 44-46, appears on page 13-16 of the Appendix to the appellant's brief. However, the Appendix also includes claims 28-30, 35, 37, 40, 41, 43, 47 and 48, which are not under appeal.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims: Claims 25-27, 31-34, 36, 38, 39, 42 and 44-46 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the stabilizer compounds in the examples (see page 12 of the spec.), does not reasonably provide enablement for the multitude of stabilizer compounds of claims 25-27, 31-34, 36, 38, 39, 42 and 44-46. The person of ordinary skill in the art would not be enabled by the specification to **make and use all** the claimed stabilizer compounds, commensurate in scope with these claims. In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

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(11) Response to Argument

In the outset, the Examiner would like to point out that the board has reviewed and affirmed similar 35 U.S.C. 112, first paragraph rejections is a case with at least one common inventor with similar subject matter. The Examiner would like to bring to the attention of the Board the decision on Appeal No. 2001-0852 "Ex parte Qi Wang and Sandor Nagy", rendered 09/06/2002 on application serial No. 09/223,710.

Regarding the reference to In re Vaeck in the Appeal Brief, contrary to appellant's assertions, the claimed novelty is in the stabilizer compounds, not in the polymers. To prepare/obtain and use at least some of the multitude of stabilizers claimed by appellant would require undue experimentation. While, Appellant's invention is in organic chemistry, the claimed stabilizers are not all well known and differ significantly from well known stabilizer compounds by more than just a hydrogen of an alkyl group. The preparation of these stabilizer compounds is also not well known.

Regarding the Declaration by Dr. Qi Wang, the blanket statements of generic mechanisms and allegedly commercially available compounds in the declaration by Dr. Wang are not sufficient evidence that appellant, at the time the application was filed, provided a description that enables each and every claimed stabilizer.

Appellant states that some of the stabilizers are commercially purchased, however, the mere statement that the compounds are commercially available is not evidence in itself of such for **all** the stabilizers.

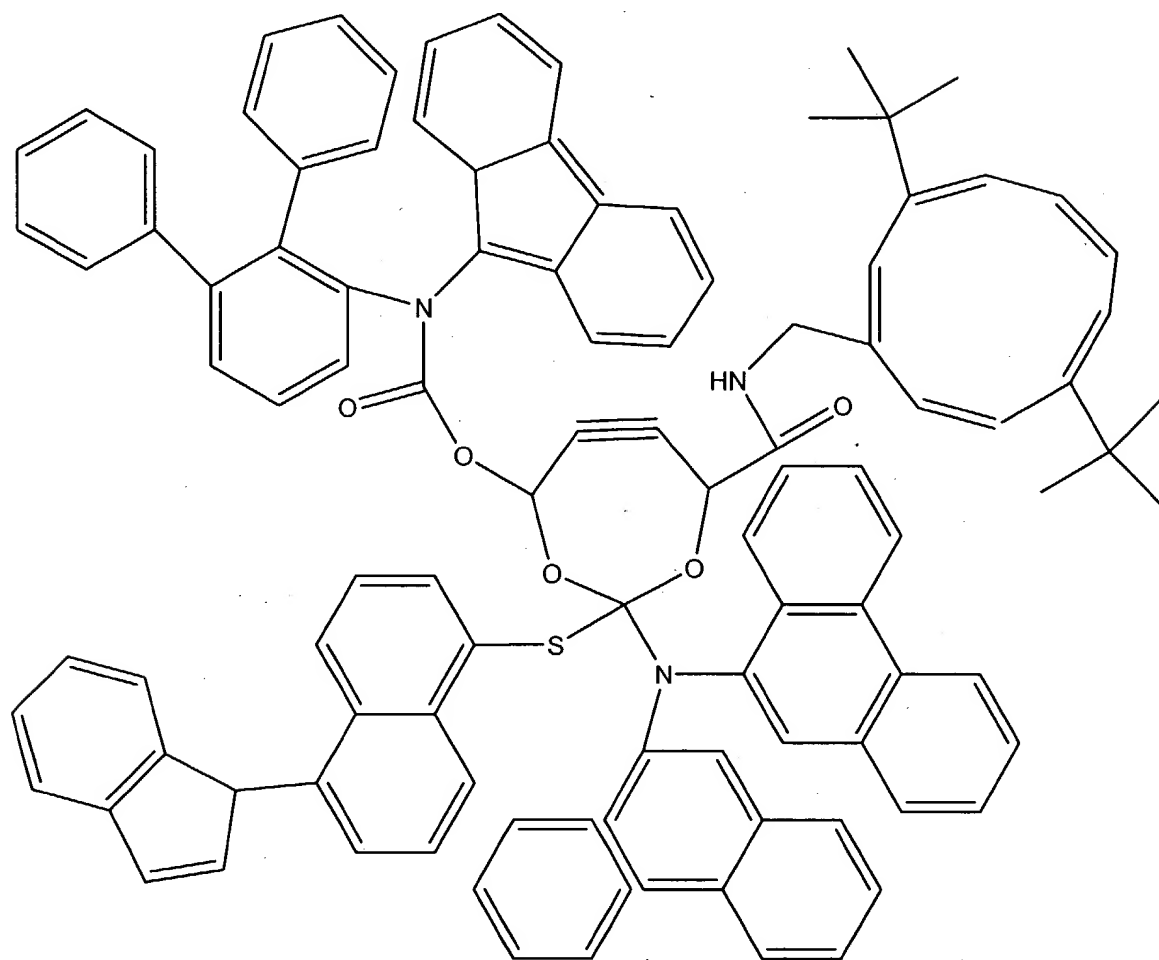
The first paragraph of 35 U.S.C. § 112 requires a reasonable correlation between the scope of what is claimed and the scope of enablement **provided by appellant's**

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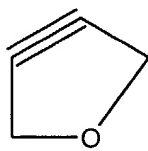
specification to the person of ordinary skill in the art. **There is simply no recitation in the original specification to reasonably provide enablement for *the multitude of divergent stabilizer compounds recited in the claims.*** There is nothing of record to indicate that the person of ordinary skill in the art would be enabled by the original specification to **make and use all** the claimed stabilizer compounds, commensurate in scope with these claims. In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Appellant has not shown how to obtain and use a sufficiently representative sample of all the stabilizers within the scope of the present claims.

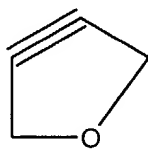
In response to appellants arguments that in the declaration, Dr. Qi Wang states that "None of the stabilizers within the scope of the claims of the above-identified patent application are difficult to synthesize and no undue experimentation would be required to synthesize them," appellant's stabilizers in the rejected claims include compounds such as:

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wherein the stabilizer is the third structure in claim 25, X is $\text{-C}\equiv\text{C-}$, one R_1 is $(\text{R})_2\text{NCO}$, the other R_1 is $(\text{R})_2\text{NCO}_2$, one R_3 is NR_2 , the other R_3 is SR and R is aryl or alkylaryl. Compounds such as above would certainly be difficult to synthesize and would require undue experimentation since the method for making/obtaining and using is not enabled in the present specification.



Appellants "stabilizers" even include , wherein the stabilizer is the fourth structure in claim 25 and X is $\text{-C}\equiv\text{C-}$, which would be highly unstable and

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would certainly not function as a stabilizer. The use of such a triple-bond ring compound with partial hydrogenation as a stabilizer is simply not enabled by the present specification, even if the compound were itself stabilizable.

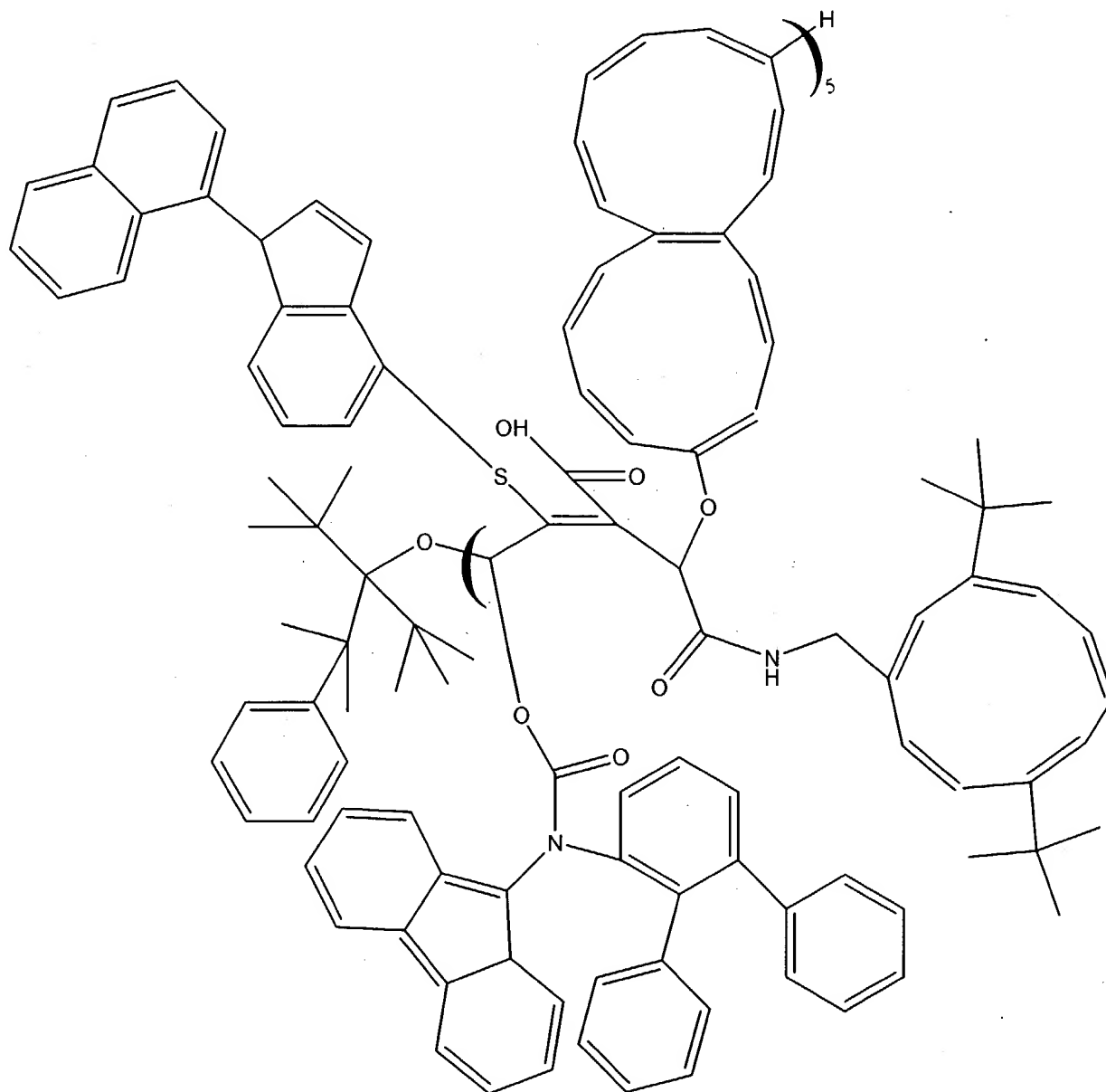
Other than some non-specific mechanisms for preparing a **small** number of the compounds appellant is claiming and the statement that **some** small number of the compounds are commercially available, wherein other unidentified compounds can be made by other unidentified but allegedly well-known techniques in the art, how to prepare **all** the compounds of the rejected claims is simply not set forth in appellant's disclosure.

As recited in appellants arguments, Dr. Qi Wang also states in the declaration that "The stabilizers within the scope of the claims of the above-identified patent application are all either commercially available or can be prepared by straightforward techniques that would be obvious to any person having a **doctorate in organic chemistry**." However the first paragraph of 35 U.S.C. § 112 requires enablement for **the person of ordinary skill in the art**, not just those with doctorate degrees, even assuming that even a person of extreme skill in the art would be enabled to make/obtain and use each claimed stabilizer compound, including the two identified above, as stabilizers in the present polymer compositions.

Regarding appellant's comparison of allowed claim 47 and the rejected claim 25 (and its dependants), it is apparent that the scopes of the two claims are infinitely different. The Examiner finds no reasonable equivalence with regard to scope between the allowed claims and the rejected.

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Regarding the rejected claims dependent from claim 25 and claims 44-46, while some of these claims may limit the stabilizer structures to some extent, none limit the stabilizer structures to the scope enabled in the present specification. For instance, even when the stabilizers are limited to the first structure of claim 44, appellant's claims still encompass compounds such as:




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which are not enabled in the specification for the person of ordinary skill in the art to make/obtain and use.

Contrary to appellant's assertions, the novelty in the claimed invention, lies in the stabilizers added to the polymer composition. The range of compounds claimed is unreasonably large in view of few compounds enabled in the present specification.


For the above reasons, it is submitted that Appellant's claims do not comply with the requirements of 35 U.S.C. 112, first paragraph and it is believed that the rejections should be sustained.


KELECHI C. EGWU PH.D.
PRIMARY EXAMINER

Respectfully submitted,

KCE
April 15, 2004

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